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#### **D. REMARKS**

##### *Specification*

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

##### *Claim Objections*

The Examiner objects to claim 46 because of an informality. In Paper No. 5, dated 10/17/03, Applicants' elected claims 1-36 and 47-52, but claim 46 remains. Applicants comply with the Examiner's request to correct the informality by amending the claims so that claim 46 reads "46. (Cancelled)".

##### *Interview Summary*

On March 11, 2004, Applicants' representative submitted an "Applicant Initiated Interview Request Form" to Examiner Barry Taylor via facsimile. Applicants' representative requested discussion of a proposed attached amendment to claim 1 and clarification of the grounds of rejection of claims 3, 4, and 29.

On March 15, 2004 at 9:00 AM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Barry Taylor. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1, and in particular a proposed attached amendment to claim 1. Specifically, the prior art cited against claim 1 is the US Patent to Swope et al. (U.S. Patent 6,639,977).

In particular, Applicant's representative proposed an amendment in advance to add an additional element to claim 1 of use of a "billing plan identifier" in lieu of an account number that would distinguish claim 1 from Swope. Applicants' representative argued that claim 1 is distinguishable from Swope because while Swope requires an entry of an account number for a pre-paid account and called party identity authentication as additional password protection

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means, claim 1 teaches accessing a callee billing plan from the authenticated identity of the callee, such that the callee need not disclose an account number. The Examiner pointed out that the element of a "billing plan identifier" was not necessary, but that by incorporating claim 2 in claim 1 and distinguishing that the callee billing plan is not a pre-paid account, claim 1 would potentially be distinguishable from Swope. Claim 2 teaches authenticating a callee identity from a voice utterance.

In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

With respect to claims 3, 5, 12, 14, 21, and 23, the Examiner clarified that the "consuming group" was interpreted as any telephone system.

With respect to claims 4, 13, and 22, the Examiner clarified that it is inherent from Figure 1, 10 that a telecommunications network teaches authenticating the identity of the called party.

With respect to claims 29, 32, and 35, the Examiner clarified that it is inferred that when a database is connected to a telephone network, that the telephone network would read billing information from the database.

**35 USC § 102(b)**

Claims 1-5, 7, 9-14, 16, 18-23, 25, 27-29, 31-32, 34-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Swope et al. (US Patent Number 6,639,977) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because the Examiner does not show that Swope teaches each and every element of claims 1-5, 7, 9-14, 16, 18-23, 25, 27-29, 31-32, 34-35 or enables each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

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**Claims 1, 10, 19, 28, 31 and 34**

With respect to claims 1, 10, 19, 28, 31, and 34, the Examiner cites Swope as teaching the method, system, and program of claims 1, 10, 19, 28, 31, and 34.

Claim 1 currently reads:

1.(Currently Amended) A method for billing for telephone services, said method comprising:

receiving, from an origin device, a destination line number for processing a call;

loading a profile for a line subscriber of said destination line number, wherein said profile comprises a line subscriber billing plan for said destination line number; and

responsive to detecting an answer to said call at a destination device accessible via said destination line number, authenticating an identity of a callee receiving said call; and

replacing said line subscriber billing plan with a callee billing plan accessed according to associated with said authenticated identity of said callee, such that said call is processed according to said callee billing plan. ~~said callee-receiving said call is billed for services requested by said callee for said call.~~

Applicants respectfully propose that Swope does not anticipate the invention of amended claims 1, 10, and 19, because Swope does not teach or enable expressly or inherently the fourth element of “replacing said line subscriber billing plan with a callee billing plan accessed according to associated with said authenticated identity of said callee, such that said call is

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processed according to said callee billing plan. ~~said callee receiving said call is billed for services requested by said callee for said call.~~”

In the objection to the original claim 1, the Examiner cites col.3, lines 5-15 of Swope as teaching the fourth element of “replacing the line subscriber billing plan with a callee (i.e. called party) billing plan associated with the authenticated identity of the callee (i.e. called party), such that the called party receiving the call is billed for services requested by the called party for the call.” (Action, p. 3-4) Col. 3, lines 5-15 of Swope reads:

“The present invention allows a calling party to call a destination number and, upon approval of the called party, reverse the billing of the telephone call so that it is deducted from an account owned and maintained by the called party other than the account associated with the destination number. Thus, the present invention provides an alternative reverse billing method to a conventional collect call. The account can be a credit card account, a checking or saving account having an associated debit or checking card, a conventional pre-paid calling card, or a special prepaid account as described herein.”

The Examiner interprets col. 3, lines 5-15 as teaching where a “called party approves billing of telephone call to an account owned by the called party to an account not associated with the destination line number.” (Action, p. 4)

Applicants amend Claim 1 to clarify that the authenticated identity is first determined and then a callee billing plan is accessed according to the authenticated identity. In addition, Applicants respectfully propose that while Swope does describe performing “customer identification and verification”, Swope does not teach using the customer identification to then access a billing plan according to the customer identification.

First, Applicants respectfully note that Swope only teaches a system where if the called party accepts the call, then the called party is prompted “for a method of payment, an account number, and an optional Customer Identification and Verification (CIV)...” (Swope col. 5, lines 27-30). A called party must enter the account number of a pre-paid account. Then, as for identity authentication, Swope teaches using the account number entered by the called party to

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lookup a prerecorded CIV from a database and comparing the current CIV with the prerecorded CIV. (Swope col. 5, lines 43-46). In contrast, claim 1 does not require entry of a method of payment or account number, but teaches first authenticating the identity of the callee and then replacing the line subscriber billing plan with a billing plan for the callee accessed according to the authenticated identity of the callee.

Second, Applicants respectfully note that a "callee billing plan" in Claim 1 is not equivalent to an "account" described in Swope. In col. 3, lines 11-14, Swope describes an account as "a credit card account, a checking or savings account having an associated debit or checking card, a conventional pre-paid calling card, or a special prepaid account." Charges for a collect call are directed to the called party account, rather than to the destination line number. In contrast, a callee billing plan replaces the destination line number billing and provides billing for all services, not just collect call services, and can also include, for example, a shipping addresses, billing addresses, and other distribution information. (Brown et al. p. 9, lines 22-27) Further, a callee billing plan may include one account provider for wireless service and another for wireline service, for example. (Brown et al. p. 11, lines 11-18).

Therefore, because the amended claims are not taught, either expressly or inherently, by Swope, claim 1 is not anticipated by Swope and should be allowed. Claims 10 and 19 are also amended in a similar manner to claim 1 and are system and program claims mirroring the method of claim 1. Thus, claims 10 and 19 are also not anticipated by Swope and should be allowed.

Claims 28, 31, and 34 are included in the rejection to claims 1, 10 and 19, however, no specific grounds for the rejection of the elements of claims 28, 31, and 34 are provided. Applicants respectfully note that the Examiner has not specified how Swope or any other reference expressly or inherently teaches each of the elements of claims 28, 31, and 34.

Claim 28 currently reads:

28. (Original)A method for callee specified telephone service, comprising:

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receiving an authenticated identity for a callee answering a call placed to a destination device;

accessing a billing plan for said authenticated identity of said callee; and

loading said billing plan for specifying charges for said call, such that telephone service billed to said callee is accessible at a plurality of destination devices.

Specifically, Applicants respectfully note that the Examiner has not specified how Swope teaches the element of "accessing a billing plan for said authenticated identity of said callee." Furthermore, as described with reference to claim 1, Swope does not teach first receiving an authenticated identity for a callee and then accessing a billing plan according to or for the authenticated identity of the callee. Similarly, claims 31 and 34 are system and program claims mirroring claims 28, but without specific grounds for rejection. Moreover, claim 31 specifically teaches a billing controller within a server system, but no billing controller within a server system is specified in the Office Action.

Therefore, because insufficient grounds for rejection of claims 28, 31, and 34 are provided, Applicants request allowance of claims 28, 31, and 34. Additionally, however, the elements of claims 28, 31, and 34 are not taught by Swope, as described with reference to claim 1, and therefore claims 28, 31, and 34 are not anticipated by Swope and should be allowed.

#### **Claims 2, 11, and 20**

Regarding claims 2, 11, and 20, Applicants respectfully propose that because the Examiner did not establish that Swope anticipates the independent claims 1, 10, and 19 upon which these dependent claims rely, Swope also does not anticipate these dependent claims and the dependent claims should be allowed. Specifically, however, Applicants respectfully propose

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that even if Swope anticipates Claims 1, 10, or 19, Swope does not anticipate claims 2, 11, and 20.

Specifically, with respect to claims 2, 11, and 20, the Examiner cites Swope, col. 8, lines 6 and 7 as teaching the method, system, and program of claims 2, 11, and 20. (Action, p. 4).

Claim 2 current reads:

2. (Original) The method for billing for telephone services according to claim 1, wherein authenticating an identity of a callee further comprises:

authenticating said identity of said callee according to a voice utterance provided by said callee.

Applicants respectfully propose that Swope does not anticipate the invention of claims 2, 11 and 20 because Swope does not teach expressly or inherently authenticating an identity of a callee by a voice utterance provided by the callee where that voice authenticated identity is then used to access a billing plan for the callee.

Swope col. 8, lines 6-7 reads "The method of claim 1, wherein the CIV includes voice recognition of the called party" where the CIV in claim 1 refers to a "Customer Identification and Verification" used to identify a number of failed CIV attempts in a predetermined database. Applicants respectfully note that Swope does not teach using voice recognition to identify a called party and then accessing a billing plan according to the called party identity. In contrast, claim 2 describes authenticating the identity of the callee from a voice utterance and claim 1 teaches accessing a billing plan according to the authenticated identity. Similarly, claims 11 and 20 teach the system and program claims mirroring the method claim 2. Therefore, because Swope does not teach each element of Claims 2, 11, and 20, Swope does not anticipate the invention of Claims 2, 11, and 20 and the claims should be allowed.

**Claims 3, 5, 12, 14, 21, and 23**

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Regarding claims 3, 5, 12, 14, 21, and 23, Applicants respectfully propose that because the Examiner did not establish how Swope anticipates the independent claims 1, 10, 19, 28, 31, and 34 upon which these dependent claims rely, Swope also does not anticipate these dependent claims and the dependent claims should be allowed. Specifically, however, Applicants respectfully propose that even if Swope anticipates claims 1, 10, 19, 28, 31, or 34, Swope does not anticipate claims 3, 5, 12, 14, 21, and 23.

Specifically, with respect to claims 3, 5, 12, 14, 21, and 23, the Examiner cites Swope col. 5, lines 38-53 and col. 6, lines 34-36 as teaching the method, system, and program claims of claims 3, 5, 12, 14, 21, and 23. (Action, p. 4).

Claims 3 and 5 currently read:

3. (Original) The method for billing for telephone services according to claim 1, wherein authenticating an identity of a callee further comprises:

initiating authentication of said identity of said callee at said origin device.

5. (Original) The method for billing for telephone services according to claim 1, wherein authenticating an identity of a callee further comprises:

initiating authentication of said identity of said callee at said destination device.

Applicants respectfully propose that Swope does not anticipate the invention of claim 3, 5, 12, 14, 21, and 23 because Swope does not teach expressly or inherently initiating authentication of the identity of the callee at the origin device or the destination device. The Examiner cites Swope col. 5 lines 38-53 as teaching a "telephone device equipped with telephone swiper (reader), a bar code scanner, an automated biometric reading device or the like reading on initiating authentication from the telephone device located at subscriber's premises

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equipment.” (Action, p. 4) Applicants respectfully propose, however, that the mere presence of a telephone swiper at a telephone device does not read on or enable initiating authentication from that device. In particular, Applicants note that where the origin device initiates authentication of a callee identity, the callee would be using a destination device equipped with the telephone swiper, not the origin device. Thus, the mere presence of equipment such as a telephone swiper at a telephone device does not read on or enable initiating authentication from that device. Further, initiating authentication requires accessing the current identity information from a callee and accessing previously recorded identity information for that callee, which is not read upon by the mere presence of a telephone swiper. Therefore, because Swope does not teach each element of Claims 3, 5, 12, 14, 21, and 23, Swope does not anticipate the invention of Claims 3, 5, 12, 14, 21, and 23 and the claims should be allowed.

**Claims 4, 13, and 22**

Regarding claims 4, 13, and 22, Applicants respectfully propose that because the Examiner did not establish that Swope anticipates the independent claims 1, 10, and 19 upon which these dependent claims rely, Swope also does not anticipate these dependent claims and the dependent claims should be allowed.

**Claims 7, 16, and 25**

Regarding claims 7, 16, and 25, Applicants respectfully propose that because the Examiner did not establish that Swope anticipates the independent claims 1, 10, and 19 upon which these dependent claims rely, Swope also does not anticipate these dependent claims and the dependent claims should be allowed. Specifically, however, Applicants respectfully propose that even if Swope anticipates claims 1, 10, or 19, Swope does not anticipate claims 7, 16 and 25.

Specifically, with respect to claims 7, 16, and 25 the Examiner cites Swope col. 1, lines 57-62 as teaching the method, system, and program claims of claims 7, 16, and 25. (Action, p. 4).

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Claim 7 currently reads:

7. (Original) The method for billing for telephone service according to claim 1, further comprising:

controlling at least one particular service provided for said call according to said at least one particular service selected in a callee profile accessible according to said authenticated identity of said caller.

Applicants respectfully propose that Swope does not anticipate the invention of claim 7, 16, or 25 because Swope does not teach expressly or inherently accessing a callee profile according to the authenticated identity of the caller. Swope col. 1, lines 57-62 reads "A need also exists for reverse billing, or called-party billing, at rates lower than those associated with normal collect calls and that allows the called party to charge the call to an account other than the telephone service account of the called number, such as a credit card account or a prepaid calling card account." While Swope teaches a type of reverse collect call service, Swope does not teach accessing a callee profile according to the authenticated identity of the caller, where the callee profile then specifies the particular types of services. In fact, Swope only teaches looking up a destination line number entered by the caller to determine if the services allowed in a profile for the destination line number include a collect call. (Swope col. 5, lines 6-10). Therefore, because Swope does not teach each element of Claims 7, 16, and 25, Swope does not anticipate the invention of Claims 7, 16, and 25 and the claims should be allowed.

**Claims 9, 18, and 27**

Regarding claims 9, 18, and 27, Applicants respectfully propose that because the Examiner did not establish that Swope anticipates the independent claims 1, 10, and 19 upon which these dependent claims rely, Swope also does not anticipate these dependent claims and

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the dependent claims should be allowed. Specifically, however, Applicants respectfully propose that even if Swope anticipates claims 1, 10, or 19, Swope does not anticipate claims 9, 18 and 27.

Specifically, with respect to claims 9, 18, and 27 the Examiner cites Swope col. 3, lines 6-10 as teaching the method, system, and program claims of claims 9, 18, and 27. (Action, p. 4-5).

Claim 9 currently reads:

9. (Original) The method for billing for telephone services according to claim 1, further comprising:

billing said callee for an order placed with a caller at said origin device according to said callee billing plan.

Applicants respectfully propose that Swope does not anticipate the invention of claims 9, 18, or 27 because Swope does not teach expressly or inherently billing the callee for (1) an order placed with a caller or (2) billing according to the callee billing plan. Swope col. 3, lines 6-10 read: "...upon approval of the called party, reverse the billing of the telephone call so that it is deducted from an account owned and maintained by the called party other than the account associated with the destination number." The Examiner interprets the scope of "order" to include a collect call that may be billed to another account associated with the called party. (Action, p. 5).

First, Applicants respectfully propose that an "order" is not the same as a "collect call." A collect call described in Swope as a service, and is cited as such by the Examiner with reference to the rejection of claim 7, 16, and 25. (Action, p. 4). Further, Applicants respectfully note that the Examiner has not shown that Swope teaches "an order placed with a caller" such that even if a collect call is an order, Swope does not teach placing that order with a caller. In contrast, claim 7 teaches billing the callee for an order placed with a caller which implies that the

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callee will be billed for a product or service provided by the caller to the callee, as detailed in the order.

Second, Applicants respectfully propose that Swope does not teach a "callee billing plan" because, as described with reference to the rejection of claim 1, an account number entered by the callee is not the equivalent of a "callee billing plan" accessed according to an authenticated identifier of the callee.

Therefore, because Swope does not teach each element of Claims 9, 18, or 27, Swope does not anticipate the invention of Claims 9, 18, or 27 and the claims should be allowed.

**Claims 29, 32, and 35**

Regarding claims 29, 32, and 35, Applicants respectfully propose that because the Examiner did not establish that Swope anticipates the independent claims 28, 31, and 34 upon which these dependent claims rely, Swope also does not anticipate these dependent claims and the dependent claims should be allowed.

***35 USC § 103(a)***

**37 CFR 1.56**

On p. 5 of the Action, the Examiner reminds Applicants of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f), or (g) prior art under 35 U.S.C. 103(a). In response, Applicants do not know of a common ownership between the claims of the present invention and the prior art cited by the Examiner in the rejections based on 35 USC 103(a). The claims of the present invention were invented as early as April 23, 2001.

**Claims 6, 15, 24, 30, 33, and 36**

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Next, claims 6, 15, 24, 30, 33, and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Reto et al (US Patent Number 5,825,857). Applicants first note the above proposition that claims 1, 10, 19, 28, 31, and 34 are not taught by Swope, and therefore as dependent claims of allowable subject matter, claims 6, 15, 24, 30, 33, and 36 should also be allowed.

The Examiner cites Swope as not showing a "service provider within an intermediary device." (Action, p. 6) However, the Examiner cites Reto as teaching "a method and system for validation hubbing wherein authorization requires is sent to the hubbing system (abstract, 400 figure 4). (Action, p. 6) Reto teaches a validation hubbing system that provides centralized protocol translation for all validation messages sent between any two networks and transport links between the network and the hubbing system (col. 3, lines 12-29). (Action, p. 6) The Examiner concludes that "it would have been obvious to any one of ordinary skill in the art at the time of the invention to modify the invention as taught by Swope to use validation hub as taught by Reto providing for a centralized translation hub that allows any two connected networks validate messages with each other regardless of the protocols each uses as taught by Reto (col. 3, line 20). (Action, p. 6)

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Furthermore, in a 103(a) inquiry, a prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. *W.L Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983, *cert. denied*, 469 U.S. 851 (1984). Of the multiple elements of claim 6, the Examiner only addresses the element of a "service provider within an intermediary device." The Examiner does not show how Swope in view of Reto teaches or suggests the other elements taught in claim 6. In particular, the last element of claim 6 currently reads: "in response to receiving a callee profile associated with said identity of said callee, wherein said callee profile comprises said a callee billing plan, replacing said destination line subscriber profile in said destination register with said callee profile, ~~such that billing for service provided for said call is directed to said callee.~~"

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Swope does not teach replacing a destination line subscriber profile with a callee profile, but teaches away from replacing a destination line subscriber profile with a callee profile; Swope only teaches directing charges for a reverse collect call to an account number input by a called party. Further, the Examiner focuses on Swope in view of Reto as teaching a centralized hub that allows two connected networks to validate messages with each other. In contrast, claim 6 teaches the limitation of replacing the destination line subscriber profile loaded into the destination register within an intermediary device with a callee profile.

Further, Applicants respectfully note that claims 6, 15 and 24 do not teach the same limitations as claims 30, 33 and 36, and therefore the combined rejection to these groups of claims appears improper. Claim 30 provides an additional limitation to accessing a billing plan where a billing plan is accessed "according to said authenticated identity from at least one data storage system outside a trusted telephone network, wherein a secure communication channel is established between said trusted telephone network and said at least one data storage system outside said trusted telephone network." As previously described with reference to claims 28, 31, and 34, the Examiner did not specify how Swope teaches "accessing said billing plan according to said authenticated identity" and does not show how Swope in view of Reto teaches this limitation.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, Applicants are not under an obligation to submit evidence of nonobviousness. As previously described, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claim 6 because the limitation of replacing a destination line subscriber profile with a callee profile is not taught or suggested by the prior art or addressed by the Examiner. Further, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claim 30 because the limitation of accessing a billing plan according to the authenticated identity of the callee is not taught or suggested by the prior art or addressed by the Examiner in the rejection of claim 30 or the rejection of claim 28 on which claim 30 is dependent. As a result of not establishing prima facie obviousness for claim 6,

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prima facie obviousness is also not established for claims 15 and 24 which are system and program claims mirroring the method of claim 6. In addition, as a result of not establishing prima facie obviousness for claim 30, prima facie obviousness is also not established for claims 33 and 36 which are system and program claims mirroring the method of claim 30.

**Claims 8, 17, 26, 47-48, and 51-52**

Next, claims 8, 17, 26, 47-48, and 51-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Kamil et al (US Patent Number 4, 706, 275). Applicants first note the above proposition that claims 1, 10, and 19 are not taught by Swope, and therefore as dependent claims of allowable subject matter, claims 8, 17, and 26 should also be allowed.

The Examiner cites Swope as not showing "routing call to service provider associated with the destination number." (Action, p. 6) The Examiner cites Kamil, however, as teaching "using a special exchange owned by service provider (see column 3) wherein a party wishes to make a telephone call, he uses the nearest available phone, removes the headset and dials a special exchange. After dialing the special exchange the caller is prompt for identifying code and the called number he wants to call. Once caller validated the special exchange decrements the subscriber's balance as the telephone progresses. In other words, Kamil provides special exchange enabling for prepayment for telephony calls which can be made from any telephone or from dedicated public telephone (col. 6, lines 6-8)." (Action, p. 7) Thus, the Examiner concludes, it "would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope to use a special exchange as taught by Kamil for the benefit of having the service provider own and control the special exchange thereby allowing any telephone to be used when making the call." (Action, p. 7)

Claims 47 and 48 currently read:

47.(Original) A method for controlling billing transactions, comprising:

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receiving a billing request from a caller during a call, wherein said billing request comprises an authenticated callee identity and callee account provider identifier; and

accessing payment for said billing request from said callee account provider according to said authenticated callee identity.

48.(Original) The method for controlling billing transactions according to claim 47, further comprising:

transferring said payment to a caller account provider according to an authenticated caller identity.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully note that claims 47 and 48 do not include the element cited by the Examiner of "routing a call to a service provider associated with the destination line number." (Action, p. 6) Further, Applicants respectfully note that the Examiner fails to point out how the combined prior art references teach or suggest the claim limitations of claims 47 and 48 of "receiving a billing request from a caller during a call, wherein said billing request comprises an authenticated callee identity and a callee account provider identifier", "accessing payment for said billing request from said callee account provider according to said authenticated identity," or "transferring said payment to a caller account provider according to an authenticated caller identity." In particular, the reference by the Examiner to a special exchange where the caller dials into a special exchange and then the special exchange decrements the caller's balance does not teach a caller submitting a billing request with an authenticated callee identity and callee account provider identifier.

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The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, Applicants are not under an obligation to submit evidence of nonobviousness. As previously described, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claims 47 or 48 because the limitation of these claims are not addressed, even indirectly, by the Examiner. As a result of not establishing prima facie obviousness for claim 47, prima facie obviousness is also not established for claims 48-52, which are dependent claims of claim 47.

In addition, regarding claims 51 and 52, the Examiner cites Swope as teaching "accessing billing information for storage system (see database 52 figure 2) within a trusted telephone network containing database 52 shown in figure 2," but that Swope does not show a "service provider used for billing." (Action, p. 7). The Examiner summarizes Kamil as providing a "special exchange enabling prepayment for telephony calls which can be made from any telephone or from dedicated public telephone (col. 6, lines 6-8)." (Action, p. 8) Thus, the Examiner concludes that "it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope to use a special exchange as taught by Kamil for the benefit of having the service provider own and control the special exchange thereby allowing any telephone to be used when making the call."

Claims 51 and 52 currently read:

51.(Original) The method for controlling billing transactions according to claim 47, wherein said billing request is received at a billing service executing within a trusted telephone network processing said call.

52.(Original) The method for controlling billing transactions according to claim 47, wherein said billing request is received at a billing service executing outside a

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trusted telephone network processing said call via a secure channel to said trusted telephone network.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner concludes that when Swope and Kamil are combined, they teach a service provider that owns and controls the special exchange, thereby allowing any telephone to be used when making the call. Applicants respectfully note that the claim limitations of claims 51 and 52 are not taught or suggested by the combined prior art references as described by the Examiner. When claims 51 and 52 are read in combination with independent claim 47, the claims teach a billing system that is located either within or outside the trusted telephone network that receives billing requests from callers, where the billing requests comprise a callee identity and a callee account provider identifier. The Examiner does not point out how the combination of the prior art references teaches a billing request which comprises a callee identity or a callee account provider identifier. Further, the Examiner does not show how the combination of the references teach a billing service able to receive billing requests from a caller which comprise a callee identity and a callee account provider identifier, where the callee is the party receiving the call, not placing the call.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, Applicants are not under an obligation to submit evidence of nonobviousness. As previously described, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claims 51 or 52 because the Examiner does not show how Swope in view of Kamil teaches or suggests a billing service able to receive billing requests from a caller which comprise a callee identity and a callee account provider identifier, whether that billing service is within or outside a trusted telephone network handling the call.

#### Claim 49

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Claim 49 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Kamil et al (US Patent Number 4, 706, 275) and further in view of O'Neil (US Patent Number 6,226,977). Applicants first note the above proposition that claim 47 is not taught by Swope, and therefore as a dependent claim of allowable subject matter, claim 49 should also be allowed. In addition, Applicants note that claim 49 is not obvious in view of Swope, Kamil and O'Neil, and therefore should be allowed.

The Examiner cites Swope in view of Kamil as not showing a "request for a fund transfer." (Action, p. 8) The Examiner cites O'Neil, however, as teaching "a method and system for providing prepaid and credit-limited telephone services wherein an announcement is played to the originating station or to the terminating station indicating that the credit limit has been exceeded (col. 5, lines 52-62, col. 15, lines 27-37). In response, an alternate payment source, such as credit or debit bank account, may be received for continuing the communication, and the cost associated with continuing the communication may be charged to the alternate payment source." (Action, p. 8) Thus, the Examiner concludes that "it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope in view of Kamil to use announcement as taught by O'Neil for the benefit of prompting the originating and terminating device for an alternate payment source so that communication may continue." (Action, p. 8-9).

Claim 49 currently reads:

49.(Original) The method for controlling billing transactions according to claim 47, wherein said billing request comprises a request for a fund transfer from said callee to said caller.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner cites the combined references as teaching an announcement used for the benefit of prompting the originating and terminating device for an

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alternate payment source so that communication may continue. Even if the combined references provide the announcement teaching cited by the Examiner, the billing request taught in claim 49 is not an announcement requesting an alternate payment source for a call to continue, but a request to a billing service for a fund transfer from the callee to the caller. Thus, Applicants respectfully note that the Examiner does not show how the combined references teach or suggest a billing request for a fund transfer as taught by claim 49 in view of 47, where the billing request includes a callee identity and callee account provider identifier and does not teach or suggest the limitation of an announcement broadcast to the originating and terminating device for an alternate payment source so that communication may continue.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, Applicants are not under an obligation to submit evidence of nonobviousness. As previously described, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claim 49 because the Examiner does not show how Swope in view of Kamil and O'Neil teaches or suggests a billing request for a fund transfer from the callee to the caller.

**Claim 50**

Claim 50 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Kamil et al (US Patent Number 4, 706, 275) and further in view of Block (US Patent Number 5,960,416). Applicants first note the above proposition that claim 47 is not taught by Swope, and therefore as a dependent claim of allowable subject matter, claim 50 should also be allowed.

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*Conclusion*

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,



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